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OFFICE OF PETITIONS

In re Application of	:
Baur et al.	:
Application No. 08/627,386	: Decision on Petition for
Filed: April 4, 1996	: Patent Term Extension
Attorney Docket No. MERCK-1753D	:
For: LIQUID CRYSTAL DISPLAY	:
DEVICES HAVING A PARALLEL	:
ELECTRIC FIELD AND WHICH < 30	:

The above-identified application has been forwarded to the undersigned for consideration on the "Request for Reconsideration of Decision on Petition for Patent Term Extension," which was received on May 10, 2006, for the above-identified application. See 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701.

The petition is **denied**.

Background

Petitioner filed a petition as a "Petition Under 37 CFR 1.181" for review of the patent term extension on March 28, 2005, for an extension of the patent term. Petitioner requested a patent term extension of 1,098 days due to delays in the Office during which the application was under appeal. On April 17, 2006, the petition was dismissed and the patent term extension was 0 days.

Petitioner notes that the above-identified application was filed on April 4, 1996, a Notice of Appeal was filed on November 21, 2001, an Appeal Brief was filed on February 28, 2002, and the Board of Patent Appeals and Interferences (BPAI) reversed the decision of the Examiner on November 22, 2004. Petitioner argues that the Notice of Allowance and Issue fee mailed on January 27, 2005, improperly failed to include a patent term extension of 1098 days. Petitioner asserts that the application is entitled to 1098 days of patent term extension and that the terminal disclaimer filed on June 4, 1999, in response to the obvious double patenting rejection in view of U.S. Patent No. 5,576,867 is not the type of terminal disclaimer specified in 35 U.S.C. 154. Petitioner argues that the statutory exclusion for patent term extension for terminal disclaimers is opposite to the usual kind of terminal disclaimer, which is filed due to a double patenting situation where an application's subject matter is patentably indistinct from that claimed in an issued patent. Petitioner argues that the statute is only applicable when a terminal disclaimer is filed in a two-way test, double patenting scenario. Petitioner argues that this application could not have been subject to the two-way test, thus the terminal

disclaimer must have been required based on the one-way test and therefore the application is entitled to 1098 days of patent term extension. In the petition received on March 28, 2005, Petitioner argued that the patent term extension should be 1,098 days. Petitioner argues that patent term extension in this application should be extended by 1,098 days and that the Office did not address his argument concerning the interpretation of the statutory language.

Applicable Statutes and Regulation

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

- (1) interference proceedings under 35 U.S.C. 135(a); and/or
- (2) the application being placed under a secrecy order under 35 U.S.C. 181; and/or
- (3) appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3), and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) with respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) the number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) the number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) the number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) the member of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) the number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

Opinion

The above-identified application was filed on November 22, 1995, which is after June 8, 1995 and before May 29, 2000, and, as a result is an application that may be eligible for patent term extension under 35 U.S.C. § 154. While the application was issued pursuant to an adverse determination of patentability by the BPAI, the application is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct.

On November 30, 1998, the examiner made a double patenting rejection in view of U.S. Patent No. 5,576,867 stating the claims if allowed, would improperly extend the right to exclude already granted in the patent. The examiner stated that the subject claimed in the instant application is fully disclosed in U.S. Patent No. 5,576,867 and is covered by the patent, since the patent and application are claiming common subject matter. In response, the terminal disclaimer was filed on June 4, 1999. Petitioner's assertion that the exclusion in 35 U.S.C. § 154 for terminal disclaimers only applies to situations in which the two-way test applies, is not persuasive. There is nothing in the statutory language with respect to the one-way or two-way test. The statute states that a "patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review" and the application for which extension is sought is subject to a terminal disclaimer.

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Decision

The prior decision which refused to grant a petition under 35 U.S.C. 154(b) and 37 CFR 1.701 for patent term extension for the delayed issuance of the patent for the above-identified patent application has been reconsidered. For the reasons stated herein, and in the previous decision, however, a patent term extension in this case cannot be granted under 35 U.S.C. § 154(b) and 37 CFR §§ 1.182 and 1.701. Therefore, the petition is **denied**.

This decision may be viewed as a final agency action. See MPEP § MPEP 1002.02(b).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Robert Clarke
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